## REMARKS

Claims 1, 19, 23, 26, 45 and 79 are pending and under examination in the subject application. Applicants note, however, that the Examiner indicated on the November 2, 2006 Office Action that claims 45-79 are pending and under examination in the subject application. Applicants herein cancel claims 1, 19, 23 and 26 without disclaimer or prejudice to their right to pursue the subject matter of these claims in the future. Applicants also add new claims 80-100 which correspond to original claims 46-66, respectively. Support for new claims 80-84 can be found in the specification at, *inter alia*, page 26, line 24 to page 27, line 23. Support for new claims 85 and 86 can be found in the specification at, *inter alia*, page 27, line 24 to page 28, line 4. Support for new claims 87-91 can be found in the specification at, *inter alia*, page 28, lines 5-12. Support for new claims 92-98 can be found in the specification at, *inter alia*, page 28 ,line 13 to page 29, line 10 and Figure 11. Support for new claims 99 and 100 can be found in the specification at, *inter alia*, page 29, line 24 to page 30, line 7. Applicants maintain that this Amendment raises no issue of new matter. Accordingly, upon entry of this Amendment, claims 45 and 79-100 will be pending and under examination.

## Restriction Requirement

In the November 2, 2006 Office Action, the Examiner asserted that the invention of Group III, which was elected, with traverse, by applicants in their August 25, 2006 Communication, reads on patentably distinct nucleic acid sequences. Specifically, the Examiner stated that claims 61

and 79 refer to Figure 11, which shows two different sequences which allegedly constitute independent and distinct inventions. Furthermore, the Examiner indicated that claims 61 and 62 recite the phrase "wherein N represents an adenosine moiety, a guanosine moiety, a cytosine moiety or thymidine moiety" and "wherein N is 1 to 4 nucleotide bases", and that applicant is required is elect a single disclosed nucleotide sequence.

In response, applicants hereby elect the covalent topo-DNA intermediate nucleotide sequence shown in Figure 11, with traverse, for prosecution at this time. In response to the restriction requirement for "N" as recited in claims 61 and 62, wherein "N" represents an adenosine moiety, a guanosine moiety, a cytosine moiety or thymidine moiety" and "wherein N is 1 to 4 nucleotide bases", applicants elect a thymidine moiety to represent "N", wherein "N" is 1 nucleotide base, with traverse, for prosecution at this time.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement.

Under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction were not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not

required, because both nucleotide sequences relate to DNA tag sequences which attach to isolated full-length mRNA. Therefore, a search of the prior art relevant to a covalent topo-DNA intermediate nucleotide sequence would provide the relevant prior art for the other nucleotide sequence shown in Figure 11, i.e., a double stranded DNA cleavage substrate. Applicants also maintain that a search of the prior art relevant to a thymidine moiety would provide the relevant prior art for a adenosine moiety, a guanosine moiety and a cytosine moiety. Since there is no burden on the Examiner to examine these nucleotide sequences and moieties together in the same application, the Examiner must examine the entire application on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §121, and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

**Species Election**

Additionally, the Examiner stated that applicants must also elect one of the following single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable:

1. Election of one promoter-enhancer sequence listed in claim 70. Claims 45-69 and 71-79 are generic.

2. Election of one epitope-tag sequence listed in claim 72. Claims 45-71 and 73-790 are generic.

3. Election of one affinity purification-tag sequence listed in claim 73.

A further sub-specie election is required for specie 3.

3i. A polyhistidine (claim 74)

3ii. A chitin binding domain or glutathione-S-transferase (claim 75)

3iii. A polypeptide which includes an intein encoding sequence (claim 76)

Applicants note that claims 70-76 were canceled in the September 19, 2003 Preliminary Amendment. Accordingly, the species election requirement for these claims is moot.

**Summary**

No fee, other than the $1590.00 fee for a four-month extension of time and the $150.00 fee for 3 additional claims, is deemed necessary in connection with the filing of this Amendment. Accordingly, a check for $1,640.00 is enclosed. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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